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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,044	06/21/2001	Stefan D. Beckers	DVP:102 US	9440
24041	7590	03/03/2004	EXAMINER	
SIMPSON & SIMPSON, PLLC 5555 MAIN STREET WILLIAMSVILLE, NY 14221-5406			DEL SOLE, JOSEPH S	
			ART UNIT	PAPER NUMBER
			1722	
DATE MAILED: 03/03/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

mk

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/830,044	BECKERS ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Joseph S. Del Sole	1722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 January 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2,3,8 and 9 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2 and 8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Election/Restrictions***

1. Newly submitted claim 3 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claim 9 is properly grouped with claim 3 (Group V in the restriction requirement of 5/23/03) and is restricted from Group IV (claim 2 in the restriction requirement of 5/23/03 and now including claim 8) because the inventions do not relate to a single general inventive concept under PCT Rule 13.1 because they lack the same or corresponding special technical features. The special technical feature of Group IV (as originally claimed) is anticipated by Henderson (US 1,654,253), Blades (3,767,756) and EP 0 483 562 A1 and does not make a contribution over the prior art. As such, unity of invention is lacking and restriction is appropriate.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 3 and 9 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

2. This application contains claims 3 and 9 drawn to an invention nonelected with traverse in the response of 6/17/03. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

***Specification***

3. The substitute specification filed 1/7/04 has not been entered because it does not conform to 37 CFR 1.125(b) and (c) because: **a)** the submission is lacking a statement that the substitute specification includes no new matter (see 37 CFR § 1.125(b)(1)).

***Claim Objections***

4. Claim 8 is objected to because of the following informalities: **a)** claim 8 is objected to because "wherein the tubular member as a guide for the tube" is grammatically incorrect. Appropriate correction is required.

5. Claim 8 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 8 does not further limit the structure of apparatus claim 2 because the limitation "the tubular member [acts] as a guide for the tube" does not structurally limit the tubular member of claim 8 from the tubular member of claim 2.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 is vague and indefinite because "a guide for the tube" is unclear because there is no antecedent basis for "the tube" and it is unclear whether the tubular member is guiding film or itself.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 2 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Blades (3,767,756).

Blades teaches an apparatus for the production of extruded blown film (Fig 2 and col 2, lines 2-10) having an extrusion means (Fig 2, #2) for continuously extruding a film; precipitation means (coagulating liquid, Fig 2, #6); draw means (Fig 2, #s 7 and 9) positioned downstream of the extrusion means for continuously drawing the extruded film from the extrusion means; a tubular member (Fig 2, #10) for containing the liquid and for receiving the extruded blown tube wherein the tubular member is situated within a precipitation bath (Fig 2, #11) and the tubular member acts as a guide for the tube (Fig 2).

***Examiner's Notes***

10. In a letter submitted 12/9/03 the Applicant requested a restart of the time period for response. The Examiner believes that this request has been rendered moot by the

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Applicant's response of 1/7/04 and the inclusion of the fee for one month extension of time.

11. The rejections of claim 2 over each of Henderson, EP0483562, and co-pending Application 10/221,597 have been overcome due to the amendment to claim 2.

***Response to Arguments***

12. Applicant's arguments filed 1/7/04 have been fully considered but they are not persuasive.

The Applicant argues that the rejection upon Blades improper.

The Examiner disagrees for the reasons set forth above.

The Applicant argues that it is not the case that Blades discloses a tubular member 11 that anticipates the tubular member claimed in pending claim 2.

The Examiner agrees that, based upon claim 2 as amended 1/7/04, member 11 does not anticipate the tubular member. However, the Applicant's amendment necessitated the new grounds of rejection which show that tubular member is anticipated by reference number 10 and is situated within precipitation bath 11.

The Applicant argues that claim 2 requires an extrusion means to extrude a cellulose solution to produce a cellulose film, but rather has structure for producing filaments.

While it may be true that Blades does not teach a cellulose solution, the argument is moot. The exact nature of the material worked upon, in this instance cellulose solution, does not further limit a structural claim. Rather, a recitation to the material worked upon is an intended use. Intended use has been continuously held not

to be germane to determining the patentability of the apparatus, *In re Finsterwalder*, 168 USPQ 530. Purpose to which apparatus is to be put and expression relating apparatus to contents thereof during intended operation are not significant in determining patentability of an apparatus claim, *Ex parte Thibault*, 164 USPQ 666. Inclusion of the material worked upon by a structure being claimed does not impart patentability to the claims, *In re Otto et al.*, 136 USPQ 458. A recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the structural limitation of that claimed, *Ex parte Masham*, 2 USPQ 2d 1647. The manner or method in which a machine is to be utilized is not germane to the issue of patentability of the machine itself, *In re Casey*, 152 USPQ 235. Additionally, *Blades* does disclose an apparatus for producing a film at column 2, lines 2-10.

### ***Conclusion***

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### ***Correspondence***

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Joseph S. Del Sole whose telephone number is (571) 272-1130. The examiner can normally be reached on Monday through Friday from 8:30 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wanda Walker, can be reached at (571) 272-1151. The official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306 for both non-after finals and for after finals.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from the either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on the access to the Private PAIR system, contact the Electronic Business Center (EBC) at 886-217-9197 (toll-free).

*Joseph S. Del Sole*

J.S.D.  
February 24, 2004



ROBERT DAVIS  
PRIMARY EXAMINER  
GROUP 1300 / 200

*2/27/04*